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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/647,374

**Applicant(s)**

HOSODA, TAKAAKI

**Examiner**

Dov Popovici

**Art Unit**

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7, 9-12 and 16-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-12 and 16-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 20 (second occurrence) been renumbered 21.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 18-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In claim 18, lines 11-12 and lines 14-16, the claim recitation of "an encoded part searching section for searching the data in the second portion of the received e-mail message for encoded data and encoding method information", and a "controlling section for controlling the decoding section to decode any encoded data in the second portion

of the received e-mail message on the basis of encoded method information" is subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Figure 2 shows "Content – Transfer – Encoding: 7 bit" and "Content – Transfer – Encoding: base 64" (see figure 2). Figure 6 shows "text searching section" and figure 5 shows "search message – ID".

However, the specification and the drawings do not show or mention "an encoded part searching section for searching the data in the second portion of the received e-mail message for encoded data and encoding method information, and a controlling section for controlling the decoding section to decode any encoded data in the second portion of the received e-mail message on the basis of encoded method information" as claimed in newly added independent claim 18.

Claims 19-21 are dependent on rejected independent claim 18 above and therefore claims 19-21 contain the same deficiency as noted and mentioned above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7, 9-12 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saito (U.S. Patent # 7,305,440).

As to claim 1, Saito discloses a data communication device for use by a person to communicate via e-mail messages having a first portion that includes a message ID and having a second portion that includes data (see figures 1-11), said data communication device comprising: a sending section (see fig. 3) for sending e-mail messages that identify e mail messages sent by the person and for storing the message IDs of the sent e mail messages (see figures 1, 2, 3 and 4); a receiving section (35) for receiving e mail messages; an outputting section (46 and/or 26) for outputting e mail messages received by the receiving section, an own information detecting section for detecting information which indicates that the person was the sender of an original e mail messages in a received e mail message by detecting whether the data in the second portion of the received e mail message includes a message ID that matches a stored message ID (see figures 6, 7, and 11, see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7, and see figure 7-9, and col. 8, line 34 to col. 9, line 39 and col. 6, lines 58-67, wherein the boundary fixed code is a character string, which is used as a boundary in the original message by IFAX at a transmitting time, reads on a message ID), and a controlling section (see figure 4) for output of said data to said data outputting section (46 or 26) if said own information detecting section detects that the person was the sender of the received email message, wherein the own information detecting section judges that the person was the

sender of the received e mail message if the data in the second portion of the received e mail message includes one of the stored message IDs.

Saito does not specifically teach that the controlling section for limiting output of said data to said data outputting section when said own information detecting section detected that the person was the sender of the received e mail message.

However, Saito does teach (1) that it is possible to identify error mail with reliability even if the mail server does not append original message to the error mail without rewriting the original message (see col. 2, lines 55-60) and (2) error information and the original document are edited to be contained in one page and output, thereby preventing a waste of recording paper (see col. 9, lines 50-56).

Therefore, it would have been obvious to one person having ordinary skill in the art at the time the invention was made and in view of Saito's teaching to have modified Saito wherein: the controlling section for limiting output of said data to said data outputting section when said own information detecting section detected that the person was the sender of the received e mail message.

It would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Saito wherein: the controlling section for limiting output of said data to said data outputting section when said own information detecting section detected that the person was the sender of the received e mail message because of the following reason(s): limiting output data only to the error message without outputting the original message (since the user already knows the original message that he or she send) will save paper supply and will prevent a waste of

recording paper as taught and suggested by Saito at column 9, lines 50-56.

Furthermore, limiting the output to the error message without outputting the original message send will save time (i.e., processing time) by displaying and/or printing only the error message (i.e., which is a smaller message). This will also reduce the bandwidth requirement for the system.

As to claim 2, Saito as modified discloses wherein said outputting section comprises a display section (see figure 4, display 46).

As to claim 3, Saito as modified discloses wherein said outputting section comprises a printing section (see figure 4, printer 26).

As to claim 4, Saito as modified discloses wherein said controlling section keeps said outputting section from outputting the data in the second portion of the received e mail message if said own information detecting section detects that the person was the sender of the received e mail message (see the discussion made in claim 1 above for more detail).

As to claim 5, Saito as modified discloses wherein said data is contained in a containing area of a memory (29), and said controlling section deletes said data from said containing area when the controlling section keeps the outputting section from outputting the data (see the discussion made in claim 1 above for more detail).

As to claim 6, Saito as modified discloses an error detecting section (41; see figures 6-11) for detecting information in the received email message which indicates that an error in communication has occurred (col. 9, line 51-56), and wherein said controlling section (see figure 4) limits output of said data, when an error has been

detected by said error detecting section and said own information detecting section detects that the person was the sender of the received email message (see the discussion made in claim 1 above for more detail).

As to claim 7, Saito as modified discloses wherein said error detecting section (41; see figure 6-11) extracts the communication error information from the first portion of the received email message, so as to output it to said controlling section (see figure 4), and said controlling section (see figure 4) outputs the communication error information inputted from said error detecting section to said outputting section (46 or 26), if an error was detected by said error detecting section (41; see figure 6-11) and said own information detecting section detects that the person was the sender of the received email message (see the discussion and argument made in claim 1 above for more detail).

As to claim 9, Saito as modified discloses wherein the sending section comprises a sending information managing section (see figures 1-4) for attaching the first portion of an email message to the second portion thereof when the person sends an e-mail (see figures 6, 7, and 11; see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7, see figure 4, 41; see figure 6-11, see figures 6, 7, and 11, see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7 and see the discussion and argument made above in claim 1 for more detail).

As to claim 10, Saito as modified discloses further comprising a text searching section (see figure 7, text searching section 201) for searching part of text from said



data, wherein said controlling section (see figure 4) outputs a part of text which is contained in said data, when an error was detected by said error detecting section and said own information detecting section detects that the person was the sender of the received e-mail message (see figures 6, 7, and 11, see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7 and see the discussion and argument made above in claim 1 for more detail).

As to claim 11, Saito as modified discloses further comprising an attached file searching section (see figure 7, original message searching section 202) for searching part of an attached file from said data, wherein said controlling section (see figure 4) outputs the part, a name of attached file, which is contained in said data, if an error was detected by said error detected section (41; see figure 6-11), said own information detecting section detects that the person was the sender of the received e-mail message (see figures 6, 7, and 11, see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7) and at least one file was attached to said data (see the discussion and argument made above in claim 1 for more detail).

As to claim 12, Saito as modified discloses further comprising a decoding section (see figure 3, expanding section 37 and decompressing 38) for decoding an encoded file (see figure 3) after detecting an encoding formula of the file attached to said data, wherein said controlling section (see figure 4) outputs a part, the content decoded from the attached file, which is contained in said data, if an error was detected by said error detecting section (41; see figure 6-11), said own information detecting section detects

that the person was the sender of the received e-mail message (see figures 6, 7, and 11, see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7) and at least one file was attached to said data (see the discussion and argument made above in claim 1 for more detail).

As to claim 16, Saito as modified discloses wherein the message ID includes a time (see figure 7-9, and col. 8, line 34 to col. 9, line 39 and col. 6, lines 58-67, wherein the boundary fixed code is a character string, which is used as a boundary in the original message by IFAX at a transmitting time, reads on a message ID includes a time).

However, Saito does not specifically specify that the message ID includes a date and a sender's email address.

However, the examiner is taking "Official Notice" that an email includes a time, a date and a sender's e-mail address is well known in the art.

Therefore, it would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Saito wherein: the message ID includes a time, a date and a sender's e-mail address.

It would have been obvious to one person having ordinary skill in the art at the time the invention was made to have modified Saito wherein: the message ID includes a time, a date and a sender's e-mail address, in order to readily and easily identify the e-mail received by the user.

As to claim 17, Saito as modified discloses wherein the controlling section includes a text searching section (see figure 7, text searching section 201) to search the

data in the second portion of the received e-mail message for text, and wherein the controlling section (see figure 4) limits what is output by the outputting section to any text detected by the text searching section if the own information detecting section detects that the person was the sender of the received e-mail message (see figures 6, 7, and 11, see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7 and see the discussion and argument made above in claim 1 for more detail).

### ***Response to Arguments***

Applicant's arguments filed 8/26/2008 have been fully considered but they are not persuasive.

With respect to Applicant argument that *"In contrast to Saito's arrangement, claim 1 is now directed to a device "for use by a person to communicate via e-mail messages having a first portion that includes a message ID and having a second portion that includes data." Claim 1 recites "an own information detecting section for detecting information which indicates that the person was the sender of an original e-mail message in a received e-mail message, "by detecting whether the data in the second portion of the received e-mail message includes a message ID that matches a stored message ID" of an e-mail message that the person has sent. It is respectfully submitted that Saito neither discloses nor suggests this technique for identifying an e-mail message that has been returned to its sender."*, the argument has been considered, but is not found to be persuasive because of the following reason(s):

Saito discloses a data communication device for use by a person to communicate via e-mail messages having a first portion that includes a message ID and having a second portion that includes data (see figures 1-11). The data communication device includes a sending section (see fig. 3) for sending e-mail messages that identify e mail messages sent by the person and for storing the message IDs of the sent e mail messages (see figures 1, 2, 3 and 4), a receiving section (35) for receiving e mail messages; an outputting section (46 and/or 26) for outputting e mail messages received by the receiving section, an own information detecting section for detecting information which indicates that the person was the sender of an original e mail messages in a received e mail message by detecting whether the data in the second portion of the received e mail message includes a message ID that matches a stored message ID (see figures 6, 7, and 11, see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7, and see figure 7-9, and col. 8, line 34 to col. 9, line 39 and col. 6, lines 58-67, wherein the boundary fixed code is a character string, which is used as a boundary in the original message by IFAX at a transmitting time, reads on a message ID), and a controlling section (see figure 4) for output of said data to said data outputting section (46 or 26) if said own information detecting section detects that the person was the sender of the received email message, wherein the own information detecting section judges that the person was the sender of the received e mail message if the data in the second portion of the received e mail message includes one of the stored message IDs.

Saito discloses a device for use by a person to communicate via e-mail messages (see figures 1-6) having a first portion that includes a message ID (see column 6, lines 60-64, note that the transmitting time in column 6, line 64 reads on: message ID) and having a second portion that includes data (see figures 5-6). Saito discloses an own information detecting section for detecting information which indicates that the person was the sender of an original e-mail message in a received e-mail message, by detecting whether the data in the second portion of the received e-mail message includes a message ID that matches a stored message ID of an e-mail message that the person has sent (see figures 6, 7, and 11, see col. 1, line 50 to col. 2, line 60, col. 3, lines 4-11, col. 8, lines 34-45, col. 9, lines 39-56, and col. 10, lines 5-7, and see figure 7-9, and col. 8, line 34 to col. 9, line 39 and col. 6, lines 58-67, wherein the boundary fixed code is a character string, which is used as a boundary in the original message by IFAX at a transmitting time, reads on a message ID).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dov Popovici whose telephone number is 571-272-4083. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 571-272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/647,374  
Art Unit: 2625

Page 14

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Primary Examiner  
Art Unit 2625

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